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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,049	11/04/2003	James R. Campbell	87020-0003 US	3113

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EXAMINER	
VIG, NARESH	

ART UNIT	PAPER NUMBER
3629	

NOTIFICATION DATE	DELIVERY MODE
07/01/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/700,049	CAMPBELL, JAMES R.	
	Examiner	Art Unit	
	NARESH VIG	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 14 recites the limitation " means for downloading matched data over the Web " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claims 6 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 4, 7, 9 and 19 – 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant's invention is for providing to a requester, selection of data/information based on the selection criteria of

the requester. Neither the preamble nor the steps recite use of machine to perform those steps. Hence it would be logical to assume that the steps could be performed by either a machine or human.

Not every "process" in the dictionary sense is a "process" under § 101. The Supreme Court has defined a "process" as involving a transformation of subject matter to a different state or thing, id. at 1398-1401, where the transformation of physical subject matter involves technology.

Based on Supreme Court precedent[1] and recent Federal Circuit decisions, A "process" under § 101 must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.[2] If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to nonstatutory subject matter

In the instant case a human can provide to a requester, selection of data/information based on the selection criteria of the requester. Thus the claimed invention does not meet the "process" requirement under § 101.

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[1] *Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876)*

[2] *The Supreme Court recognized that this test is iiot necessarily fixed or perinanent and may evolve with technological advances. Gottschalk v. Aenson, 409 U.S. 63, 71 (1972)*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3 – 10 and 12 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over archived web pages of Realtor.com hereinafter known as Realtor in view of screen images of Realtor Workstation.

Regarding claims 1, 10 and 19, Realtor teaches a multiple listing service (MLS) data redistribution system and method. Realtor teaches:

retrieving MLS data (MLS data from Realtor is retrieved from plurality of regional MLS) [Realtor, pg 34];

obtaining and retrieving selection data from a subscriber (Realtor teaches capability for enabling a user to enter search criteria) [Realtor, pg 42];

processing, matching and forming the MLS data with the subscriber selection data (Realtor teaches capability for selecting real estate based on user search criteria);

Realtor does not explicitly teach distributing the matched MLS data and the subscriber selection data to the subscriber. However, Realtor teaches its system is available to all users. RealtorWorkstation teaches distributing the matched MLS data and the subscriber selection data to the subscriber [RealtorWorkstation, pg 2].

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Realtor by adopting teachings of RealtorWorkstation to restrict availability of data to paying customers, combine prior art elements according to known methods to yield predictable results, applying a known technique to a known device or method ready for improvement to yield predictable result.

Regarding claims 3 and 12, Realtor in view of RealtorWorkstation teaches capability wherein the subscriber selection data comprises a customer list (agent can enter list of search criteria provided to the subscriber from their customer);

Regarding claim 4, Realtor in view of RealtorWorkstation teaches capability wherein the subscriber selection data comprises a property identification list [RealtorWorkstation, pg 13].

Regarding claims 5 and 14, Realtor in view of RealtorWorkstation teaches capability wherein distributing the matched MLS data and the subscriber selection data to the subscriber comprises

downloading matched data over the Web [Realtor and RealtorWorkstation teach this capability];

automatically retrieving the matched data using a web service [Realtor and RealtorWorkstation teach this capability];

automatically accessing and retrieving the matched data through a web site [Realtor and RealtorWorkstation teach this capability]; and

e-mailing the matched data [RealtorWorkstation pg 55 teach this capability].

Regarding claims 6 and 15, Realtor in view of RealtorWorkstation teach capability for:

receiving and storing data from said means for retrieving MLS data;

retrieving selection data from a subscriber;

processing and matching the MLS data with the subscriber selection data.

Regarding claims 7 and 16. Realtor in view of RealtorWorkstation teaches capability wherein distributing the matched MLS data and the subscriber selection data to the subscriber comprises electronically filtering confidential customer data [RealtorWorkstation, pg 45, customer listing synopsis filters out the listing contact information]

Regarding claims 8 and 19, Realtor in view of RealtorWorkstation teaches capability wherein distributing the matched MLS data and the subscriber selection data to the subscriber comprises means for encrypting the matched data. Using encryption for data transmission is old and known technology which one of ordinary skill in the art can modify Realtor in view of RealtorWorkstation and use encryption to combine prior art elements according to known methods to yield predictable results, applying a known

technique to a known device or method ready for improvement to yield predictable result.

Regarding claims 9 and 18, Realtor in view of RealtorWorkstation teaches capability wherein the subscriber is a mortgage lender or a mortgage broker.

Regarding claim 20, Realtor in view of RealtorWorkstation teaches capability for periodically repeating the retrieving, obtaining, processing, and distributing steps.

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over archived web pages of Realtor.com hereinafter known as Realtor in view of screen images of Realtor Workstation and Milman et al. US Publication 2008/0097767.

Regarding claims 2 and 11, Realtor in view of RealtorWorkstation does not explicitly recite reporting the matched MLS data and the subscriber selection data to a provider of the MLS data. However, Milman teaches capability for reporting the matched MLS data and the subscriber selection data to a provider of the MLS data [Milman, Fig 2b, 6c and disclosure associated with the figure].

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Realtor in view of RealtorWorkstation by adopting teaching of Milman to enable the MLS data provider to determine what selections met the search

criteria of the client), combine prior art elements according to known methods to yield predictable results, applying a known technique to a known device or method ready for improvement to yield predictable result,

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. McDonald et al. US Patent 7,315,841
2. Broerman US Patent 6,594,633

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Naresh Vig/
Primary Examiner,
Art Unit 3629

June 22, 2008